

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 2, 5-11, 14-17, and 20-24 are currently pending. Claims 1, 2, 8, 15, 16, and 17 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1, 8, and 16 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement; Claims 1, 2, 5, 6, 8, 9, 11, 14-17, 20, 21, 23, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,330,070 to Toyoda et al. (hereinafter “the ‘070 patent”) in view of U.S. Patent No. 6,633,413 to Schlank et al. (hereinafter “the ‘413 patent”); and Claims 7, 10, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘070 and ‘413 patents, further in view of U.S. Patent No. 6,512,593 to Yashiki (hereinafter “the ‘593 patent”).

Amended Claim 1 is directed to a method for transmitting a facsimile, comprising: (1) creating an image; (2) inputting parameters of a fax machine to a graphical user interface of a general purpose computer, the parameters including a password of the fax machine; (3) forming an electronic mail address that always includes an Internet electronic mail address of the fax machine, the input password of the fax machine, and a receiver fax number; (4) generating a fax request as an electronic mail message, the electronic mail message including electronic mail address and the image; and (5) transmitting the electronic mail message to the fax machine; and (6) determining whether to print the image at the fax machine or forward the image to a second fax machine corresponding to the receiver fax number based only on the electronic mail address. Further, Claim 1 recites that the fax machine has only one password, and the receiver fax number and the password of the fax machine are always

included in the electronic mail address. The changes to Claim 1 are supported by the originally filed specification and do not add new matter.¹

Applicants respectfully submit that the rejections of Claims 1, 8, and 16 under 35 U.S.C. § 112, first paragraph, are rendered moot by the present amendment to those claims. For example, Claim 1 no longer recites “even if the image is not to be sent to the second fax machine.” Further, Applicants note that Figure 8 of the specification discloses that a receiver fax number is always included in the electronic mail address. See page 9, lines 4-8 of the specification. Accordingly, Applicants respectfully submit that the rejections of the claims under 35 U.S.C. § 112 are rendered moot by the present amendment to Claims 1, 8, and 16.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103, the Office Action asserts that the ‘070 patent discloses everything in Claim 1 with the exception of a graphical user interface, and relies on the ‘413 patent to remedy that deficiency.

The ‘070 patent is directed to a method for receiving and relaying an e-mail message based on whether a public mail address or a non-public mail address is used. In particular, as shown in Figs. 4 and 5, the ‘070 patent discloses a method in which, if a first password name is used, the message is printed at the relay fax machine, whereas if a second password name is used along with a destination telephone number, the message is sent to the fax machine at the destination telephone number.² However, Applicants respectfully submit that the ‘070 patent fails to disclose forming an electronic mail address that always includes an Internet electronic mail address of a fax machine, and input password of the fax machine, and a receiver fax number, wherein the fax machine has only one password, and the receiver fax number and the password of the fax machine are always included in the electronic mail address, as recited in amended Claim 1. Rather, the ‘070 patent discloses the use of two

¹ See, e.g., Figs. 6-9 and the discussion related thereto in the specification.

² See, ‘070 patent, Figs. 4 and 5.

different password names in the electronic mail address, one for relay and one for public use. Further, Applicants note that amended Claim 1 recites the step of determining whether to print the image at the fax machine or forward the image to a second fax machine corresponding to the receiver fax number based only on the electronic mail address. In this regard, Applicants note that the '070 patent attempts to distinguish between public use and relay based on the password name and the optional use of a destination telephone number, as shown in Figs. 4 and 5. However, Applicants respectfully submit that the '070 patent fails to disclose the electronic mail address recited in Claim 1.

The '413 patent is directed to a system for managing printing, scanning, and faxing of a fax machine via a bidirectional parallel interface. Figures 11-15 disclose managing fax numbers and fax groups. However, Applicants respectfully submit that the '413 patent fails to disclose forming an electronic mail address that always includes an Internet electronic mail address of a fax machine, an input password of the fax machine, and a receiver fax number, wherein the fax machine has only password and the receiver fax number and the password of the fax machine are always included in the electronic mail address, as recited in amended Claim 1.

Thus, no matter how the teachings of the '070 and '413 patents are combined, the combination does not teach or suggest forming an electronic mail address that always includes an Internet electronic mail address of the fax machine, the input password of the fax machine, and a receiver fax number, wherein the fax machine has only one password, and the receiver fax number and the password of the fax machine are always included in the electronic mail address, as recited in amended Claim 1. Accordingly, Applicants respectfully submit that the rejection of Claim 1 (and dependent Claims 2, 5, and 6) is rendered moot by the present amendment to Claim 1.

Independent Claims 8 and 16 recite limitations analogous to the limitations recited in Claim 1. Moreover, Claims 8 and 16 have been amended in a manner analogous to the amendment to Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that the rejections of Claims 8 and 16 (and all similarly rejected dependent claims) are rendered moot by the present amendment to Claims 8 and 16.

Regarding the rejection of Claims 7, 10, and 22 under 35 U.S.C. § 103, Applicants respectfully submit that the '593 patent fails to remedy the deficiencies of the '070 and '413 patents, as discussed above. Accordingly, Applicants respectfully submit that the rejections of Claims 7, 10, and 22 are rendered moot by the present amendment to the independent claims.

Claim 23 recites a graphical user interface, comprising: (1) a control window configured to input fax parameters of a fax machine; (2) a settings window configured to input setup parameters of the fax machine and mail parameters in order to send an electronic mail message, the setup parameters including a password of the fax machine; and (3) a print window configured to select a print driver to convert a computer document to a fax format.

Regarding the rejection of Claim 23 under 35 U.S.C. § 103, the Office Action refers to the rejection of Claims 1 and 11. However, Applicants respectfully submit that the '413 patent fails to disclose a setting window configured to input a password of the fax machine. The passage cited by the Office Action (Col. 2, lines 50-64) in the '070 patent fails to disclose a graphic user interface including a setting window configured to input a password of a fax machine, as recited in Claim 23. Further, Applicants respectfully submit that the '413 patent fails to remedy the deficiencies of the '070 patent. Accordingly, Applicants respectfully submit that no matter how the teachings of the '070 and '413 patents are combined, the combination does not teach or suggest the settings window recited in Claim

23. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and the rejection of Claims 23 and 24 should be withdrawn.

Thus, it is respectfully submitted that independent Claims 1, 8, 16, and 23 (and all associated dependent claims) patentably define over any proper combination of the '070, '413, and '593 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Kurt M. Berger

James J. Kulbaski
Attorney of Record
Registration No. 34,648
Kurt M. Berger, Ph.D.
Registration No. 51,461

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

JJK/KMB/law

I:\ATTY\KMB\196's\196033US\196033US-AF.DOC